

IN SENATE
Supreme Court of the United States

October Term, 1943.

No. 1042

LINE MATERIAL COMPANY AND WILLIAM O. SCHULTE,

Petitioners,

vs.

CASPER W. GOME, COMMISSIONER OF PATENTS,

Respondent.

**SECOND PETITION OF LINE MATERIAL COMPANY
AND WILLIAM O. SCHULTE FOR A WRIT OF
CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE DISTRICT OF COLUMBIA.**

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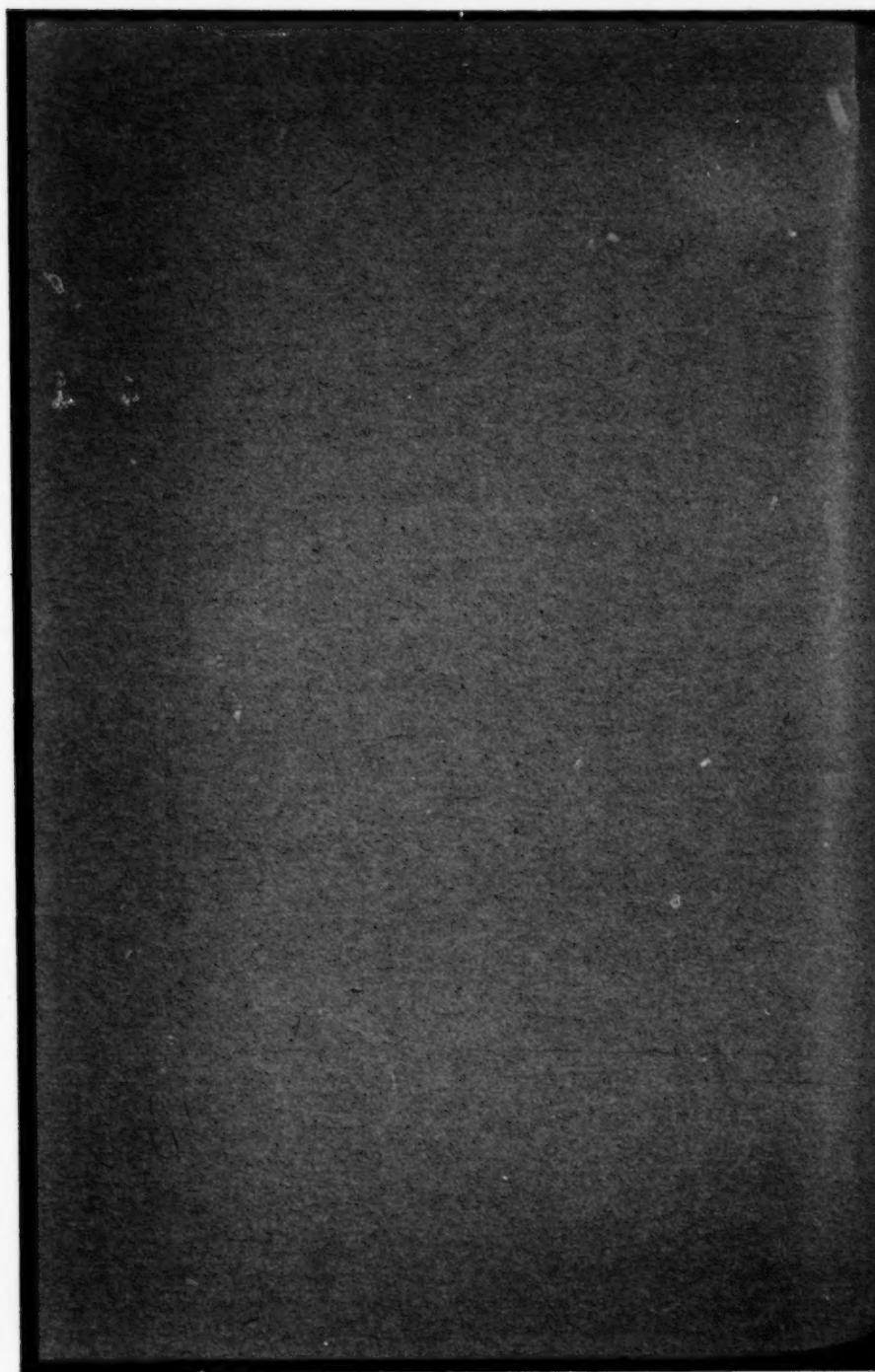
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Of Counsel.

Dated: Chicago, Illinois,

March 25, 1944.



INDEX.

	PAGE
Jurisdiction	2
Questions Presented	3
Summary and Short Statement of Matter Involved....	4
Reasons for Granting the Writ.....	8
Brief in Support of Petition for Writ of Certiorari....	12
Opinions of Courts Below.....	12
Jurisdiction	12
A Statement of the Case and Questions Involved..	12
Specification of Errors	13
Summary of Argument	14
Argument	15
Introductory Matter Leading Up to the Decision of the Court of Appeals.....	15
Question or Point 1.....	18
Question or Point 2.....	21
Conclusion	24

TABLE OF CASES.

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45.....	16
Ellis v. Shaw, 295 Fed. 1006.....	8, 10, 16, 22, 23
Hoover v. Coe, 144 Fed. (2) 514.....	5
Hoover v. Coe, 325 U. S. 79.....	3
Line Material, et al. v. Coe, 40 Fed. Supp. 633.....	5, 12
Line Material, et al. v. Coe, 144 Fed. (2) 518.....	5, 12
Line Material, et al. v. Coe, 152 Fed. (2) 665.....	6, 12
Line Material, et al. v. Coe, 65 USPQ 237.....	3, 6, 12
In Re Manson, 45 App. D. C. 563.....	15
Prescott, et al. v. Swain, et al., 22 Fed. (2) 1004.....	16, 23
Prescott, et al. v. Swain, 39 Fed. (2) 241.....	8, 10
Rogers, et al. v. Aikman, 277 Fed. 617.....	16
Special Equipment Co. v. Coe, 65 S. C. 741.....	
.....	3, 8, 9, 12, 13, 19, 24

APPENDIX.

Statutes:

Sec. 4884 (U.S.C. Title 35, Sec. 40).....	27
Sec. 4886 (U.S.C. Title 35, Sec. 31).....	27
Act of August 5, 1939, 53 Stat. 1212, Sec. 2.....	28
Sec. 4911 (U.S.C. Title 35, Sec. 59a).....	28
Sec. 4915 (U.S.C. Title 35, Sec. 63).....	29
Sec. 240 (a) of the Judicial Code (28 U.S.C. Title 347)	30
March 26, 1946.	

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**SECOND PETITION OF LINE MATERIAL COMPANY
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OF APPEALS FOR THE DISTRICT OF COLUMBIA.**

Your petitioners, Line Material Company and William O. Schultz, respectfully pray for a writ of certiorari to the United States Court of Appeals for the District of Columbia to review the judgment of that court entered on the 17th day of December, 1945,¹ (petition for rehearing denied January 7, 1946).² A transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

1. Rec. p. 136.

2. Rec. p. 140.

This is the Second Petition to this Court filed by your petitioners in the above entitled cause; the first petition, which was not opposed by the defendant, having been granted by this Court on May 7, 1945.³ In the first petition your petitioners raised the same point as is here presented in addition to a question of jurisdiction not herein involved.

Jurisdiction.

The basis upon which it is contended that this Court has jurisdiction to review the judgment in question is:

1. The judgment was rendered in a civil action brought under the patent statutes to secure an adjudication that the petitioners are entitled, according to law, to receive a patent for the invention as specified in Claims 46, 48 and 49 of a pending application for patent.

2. The judgment to be reviewed is the District Court's judgment of January 18, 1943,⁴ affirmed by the Court of Appeals on December 17, 1945⁵; petition for rehearing having been denied on January 7, 1946.⁶

3. The Courts below have decided a question of general importance and of substance relating to the construction or application of Sec. 4915 of the Revised Statutes 35 U. S. C. A. 63, which although not specifically settled by this Court has been decided in such a manner as to contravene the principles of law recently announced by the Supreme Court in the case of **Special Equipment Co. vs. Coe** 65 SC 741 wherein the Supreme Court reversed the present Circuit Court of Appeals on an analogous question in a suit under Sec. 4915 R.S.

3. Rec. p. 133.

4. Rec. p. 16.

5. Rec. p. 136.

6. Rec. p. 140.

4. The statute under which jurisdiction is invoked is 240 (a) of the Judicial Code, 28 U.S.C.A. 347, as amended, by the Act of February 13, 1925.

5. Cases believed to sustain jurisdiction are:

Special Equipment Co. v. Coe, 65 SC 741.

Hoover v. Coe, 325 U.S. 79

Line Material v. Coe, 65 U.S.P.Q. 237, Decided by this Court on May 7, 1945.

Questions Presented.

The questions, which involve the construction of the Constitution and Patent Laws enacted pursuant to the Constitution, are:

1. Whether, as the Court of Appeals of the District of Columbia held, an applicant for letters patent may properly be refused his remedy under Section 4915 on the independent conclusion of the Court that the mechanical structure involved in the claims sought was not shown to be clearly and positively necessary? This question corresponds substantially with Question 3 of your petitioners' previous Petition granted by this Court; and is of the same general character as was passed upon by this Court in the recent special equipment case where the present Court of Appeals was reversed for conditioning a patent grant on a showing of use of the invention.

More specifically stated, where the Court finds that in an applicant's structure, a fuse tube is biased downwardly thereby contributing to the releasing of a latch called for in the claims sought should claims on such structure be denied solely on the Court's own independent conclusion that the force flowing from the movement of the fuse tube was gratuitous and not imperative to the unlatching operation? That is to say, is it a prerequisite to a patent, on an

otherwise admittedly patentable structure, that the applicant establish that a particular element or feature of the structure claimed is indispensable in the use of the structure?

2. Where in a suit under Section 4915 the plaintiffs sustained their burden of proof by showing through uncontroverted testimony of a man found to be highly skilled in the art that the fuse structure of the claims on which a patent is sought is inherent in the disclosure of the application, and as established by uncontroverted models, may a Federal Court in the absence of any testimony on the part of the defendant Commissioner of Patents, other than the unsworn to actions of the Patent Office Examiners, who were not made available for cross-examination, properly refuse such claims solely because the Court concluded that certain features of the claimed fuse structure were not shown to be necessary for the operation of the same?

Summary and Short Statement of the Matter Involved.

1. On May 24, 1934, petitioner, William O. Schultz, filed an application for a patent for an electrical fuse construction which received Serial No. 727,450,⁷ and which was assigned to petitioner, Line Material Company.⁸

2. Petitioners sought a patent on this application to cover the invention thereof as defined in claims 46, 48 and 49 of said application.⁹

3. On March 11, 1942, the Board of Appeals refused a patent on this application as to these claims, ruling that such claims were not supported by the disclosure in the

7. Rec. p. 3, par. 6.

8. Rec. p. 3, par. 7.

9. Rec. p. 3, par. 9.

application.¹⁰ Such claims are conceded by the Patent Office to be patentable.

4. Petitioners did not take an appeal to the United States Court of Customs and Patent Appeals but exercised the alternative remedy provided for by Section 4915 of the revised Statutes (U.S.C. Title 35, Sec. 63)¹¹ by filing thereunder, on August 3, 1942, a timely bill in equity in the United States District Court for the District of Columbia.¹²

5. The defendant below admitted in its answer that your petitioner, William O. Schultz, is the first inventor of the inventions disclosed in his application and was the senior party in a previously terminated Patent Office interference proceeding.¹³

6. A trial was had on the merits, the defendant offering no evidence other than the Patent Office record, and, on January 18, 1943, the District Court entered judgment (40 Fed. Sup. 633) on the merits and dismissed petitioners' complaint,¹⁴ from which, on February 16, 1943, an appeal was taken to the United States Court of Appeals for the District of Columbia.¹⁵

7. The Court of Appeals in a decision 144 Fed. (2) 518 dated July 10, 1944,¹⁶ under the authority of *Hoover v. Coe* 144 Fed. (2) 514, decided the same date, affirmed the Lower Court's dismissal of the complaint.

8. A petition for writ of certiorari was then filed, **which**

10. Rec. pp. 122-124.

11. Rec. p. 7, par. 24.

12. Rec. p. 2.

13. Rec. p. 9. The complaint so alleged (Pars. 5, 6 and 10; Rec. pp. 2, 3 and 4). These allegations were admitted (Ans. par. 1, Rec. p. 9).

14. Rec. p. 16.

15. Rec. p. 17.

16. Rec. p. 129.

was not opposed by defendant, and this Court on May 7, 1945, granted the petition, 65 Sup. Court 1182, and reversed the judgment and remanded the cause to the United States Court of Appeals for the District of Columbia for further proceedings. In that petition your petitioners in the first two questions presented raised the matter of jurisdiction and in the third question raised a question that is submitted in the present Second Petition for Writ of Certiorari.

9. The Court of Appeals on July 5, 1945,¹⁷ entered an order recalling its mandate of August 17, 1944, and on October 8, 1945, entered an order setting the case down for hearing on October 27, 1945. On December 17, 1945, the Court of Appeals rendered a new decision 152 F (2) 665¹⁸ on the merits and affirmed the Lower Court's judgment dismissing the Bill of Complaint.¹⁹

Your petitioners thereupon filed with the Court of Appeals a petition for re-hearing under Rule 26, which petition was denied by the Court of Appeals on January 7, 1946.²⁰

10. The material facts with respect to this application upon which the Lower Court sustained the Patent Office in its refusal to grant the applicant a patent with Claims 46, 48 and 49 of said application are as follows:

(a) **There is no question of the patentability of these claims involved in the case.**²¹ The issue is whether or not your petitioners, by reason of the original Schultz application and inherent operation of the fuse therein disclosed are entitled to these three claims directed to a

17. Rec. p. 134.

18. Rec. p. 136.

19. Rec. p. 139.

20. Rec. p. 140.

21. Rec. p. 137.

fuse cooperating with latch means in the release of the latter.

(b) In the trial below, your petitioners, to meet the issue presented by the Patent Office's decision, presented testimony²² of one skilled in the art together with models of the devices of the application; and the Lower Courts notwithstanding the fact that the Commissioner did not offer any testimony to refute that of the plaintiffs ruled against plaintiffs. In making this ruling the District Court made a Finding of Fact²³ to the effect that "The evidence shows that plaintiffs' expert witness, as one man skilled in the art and perhaps exceptionally so, did construct models wherein the springs coiled about the fuse tube, presumably did expedite, to some degree, the consummation of the unlatching process. * * *"

The District Court made a further Finding²⁴ reading **"Granting, however, that such operation might be held to be inherent in the fuse structures** illustrated by Figures 1, 4 and 5 of the application drawings and in the unquestioned models which were demonstrated by plaintiffs' witness, a man skilled in the art, who testified that these springs must function in order that a final release of the latch may be effected, it is held that to permit plaintiffs to claim a fuse with such operation as in Claims 46, 48 and 49 and to amend the specification to cure the deficiencies, would result in new matter being introduced in the application."

11. The Court of Appeals in its decision of December 17, 1945,²⁵ on the merits properly ruled with respect to the foregoing matter that under the established practice ap-

22. Rec. pp. 32 to 80.

23. Rec. p. 14.

24. Rec. p. 16.

25. Rec. p. 136.

proved by the Courts **an applicant for patent should not "be denied the inherent concomitants of his invention even in the presence of a description that is inconsistent with the fact of operation"**²⁶ and that that was "particularly true, where, as here, the language used appears to be primarily directed toward describing a mechanical arrangement of parts rather than the functioning of the device." The Court in this regard cited with approval *Ellis v. Shaw*, 295 Fed. 1006 and *Prescott et al. v. Swain*, 39 Fed. (2) 241, which were relied upon by plaintiffs.

The Court of Appeals, however, still affirmed the Judgment, **dismissing the Bill, on its own independent conclusion that** while "the fuse tube in biasing downward possibly contributes to the releasing action" **such force was not shown to be necessary** and hence the applicant was not entitled to the claims.

Reasons for Granting the Writ.

1. The decision of the Court of Appeals in this case is in direct conflict with and contrary to the Constitution and the patent statutes, enacted pursuant thereto, and the uniform decisions of this and all other United States Courts and including the recent decision in the case of **Special Equipment Co. v. Coe**, 65 S.C. 741 wherein this Court reversed the present Court of Appeals on much the same type of question although not identical, as is here presented.

2. The decision of the Court of Appeals refuses admittedly patentable claims in a suit under Sec. 4915 R.S. (35 U.S.C.A. 63) solely because the Court concluded that a certain feature of the claims found to be inherently present in the applicant's disclosed structure **was not shown to be necessary, or in other words, indispensable.**

26. Rec. p. 138.

3. The decision of the Court below contravenes the spirit and intent of the Constitution especially since Congress, in the choice of means of promoting the useful arts by patent grants, did not in any way condition such grant on a showing of the necessity for a useful and novel feature of a claim found upon due examination by the Patent Office to embrace patentable subject-matter.

4. In the Special Equipment case (*Supra*) this Court found the Court of Appeals for the District of Columbia to be in error in independently concluding that a grant of patent is **conditioned on a showing of use** of the invention. The Circuit Court here indulged in a similar error, but on a slightly different premise, namely, that of conditioning the patent grant on a showing of necessity or indispensability of the invention notwithstanding the complete absence of any legal authority, either in the decisions or statutes, for making such a condition a prerequisite to a patent.

5. The decision below, if not reversed, creates and applies a bar which very substantially impairs the patent system and which, if followed by the Patent Office and Courts, would unduly complicate the issuance and construction of patents in a manner not in any way contemplated by the patent laws promulgated by Congress. Therefore, there is here a question of *tremendous public importance*, not only throughout this land, but all foreign countries accorded reciprocity privileges regarding patents here.

6. The Court of Appeals' decision if allowed to stand negatives the remedy afforded applicants for Letters Patent by Sec. 4915 of the R. S. and denies an applicant his statutory right under Section 4886 of the Revised Statutes, 35 U.S.C.A. 31, which authorizes "any person who has invented * * * any new and useful * * * machine to obtain a patent."

7. Furthermore, the adverse ruling of the Court of Appeals, in the absence of any testimony at all by the defendant, other than the unsworn to actions in the Patent Office Record, is contrary to the previous decisions of the Court of Appeals of the District of Columbia, such as in the cases of *Ellis v. Shaw*, 295 Fed. 1906 and *Prescott et al. v. Swain* 39 F. (2) 241. The plaintiffs have established by unrefuted testimony of a witness skilled in the art that the subject-matter of the claims in suit is inherent in the disclosure of the application of the plaintiffs and under the established practice of the aforesaid decisions in suits, under Section 4915 R.S. the plaintiffs should have been granted the claims sought.

8. This Court previously granted your petitioners first petition for writ of certiorari in which among the questions raised was one of merits also presented by this Second Petition. This Court in its *Per Curiam* decision stated that the judgment of the Court below was reversed on the authority of *Hoover Company v. Coe*, decided April 3, 1945, (*supra*) which, it is true, had to do with the question of jurisdiction and did not specifically refer to the question of merits here raised. Hence this Court should grant this petition so as to settle this question which involves the very essence of our Patent system.

9. In making a ruling that the plaintiffs had made no showing of necessity for the feature of the invention in issue, even assuming that the same was a requirement to the grant of a patent, since the patent application itself on the very first page thereof, in the statement of the objectives specifically states that **the biasing of the tube aids in quickly extinguishing the arc upon blowing of the fuse.** The testimony of Mr. McNulty, who was found to be highly skilled in the art, also substantiates this showing.

Wherefore, your petitioners respectfully pray that a

writ of certiorari issue out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding said court to certify and send to this Court, on a date to be designated, a full transcript of the record and full proceedings had in this case, to the end that this case may be reviewed and determined by this Court as to the questions presented hereby as well as to the question of whether petitioners are entitled, according to law, to receive a patent for their said invention, and that the judgment of the courts below be reversed, and that these petitioners may be granted such other and further relief as may seem proper.

Respectfully submitted,

CHARLES F. MERONI,

CARLTON HILL,

Counsel for Petitioners.

WILLIAM A. SMITH, JR.

Of Counsel.

Dated: Chicago, Illinois,

March 26, 1946.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

1. The District Court's decision, on the merits, dismissing the bill, dated January 18, 1943,¹ 40 Fed. Sup. 633.
2. The Court of Appeals' decision affirming the judgment below but on the ground of lack of jurisdiction and not on merits, dated July 10, 1944,² 144 Fed. (2d) 518.
3. The *Per Curiam* decision of this Court granting the Petition for a Writ of Certiorari and reversing the judgment below dated May 7, 1945.³ 65 U.S.P.Q. 237.
4. The Circuit Court of Appeals' decision, after the remanding of the case, affirming the judgment below dismissing the bill dated December 17, 1945.⁴ 152 Fed (2d) 665.

Jurisdiction.

The petition sets forth on page 2 the grounds on which jurisdiction is invoked and your petitioners particularly relied upon this Court's decision in the case of *Special Equipment Co. v. Conway P. Coe case*, 65, S.C. 741.

A Statement of the Case and Questions Involved.

The Petition sets forth, beginning with Page 3, a statement of the questions involved in this case, which is followed by a brief summary of the material facts necessary

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1. Rec. p. 16.
 2. Rec. p. 129.
 3. Rec. p. 133.
 4. Rec. pp. 136-138.

to an understanding and the reasons relied upon for the allowance of the Writ. For sake of brevity they are not being here repeated.

Specification of Errors.

The Court of Appeals for the District of Columbia, in deciding the case, erred:

1. In ruling that while the plaintiffs were entitled to all of the inherent concomitants of the invention in view of the practice announced in the *Ellis* and *Prescott* cases,⁵ the applicant must be refused the claims since he had failed to show wherein the feature of the claim in question was necessary (indispensable) in the operation of the device claimed.

2. In conditioning the grant of a patent on a showing of necessity, notwithstanding the entire absence of law justifying such an extension of the requirements for the grant of a patent, and contrary to the ruling of this Court in the case of *Special Equipment Co. v. Coe*, *supra*, wherein it was held to be a reversible error to condition the grant of a patent on a showing of use of the invention.

3. In promulgating an additional requirement for the grant of a patent, namely, one directed to showing the necessity for a feature of the invention claimed, contrary to the Constitution and Statutes of the United States and the decision of this Court in the case of *Special Equipment Co. v. Coe supra*, which specifically ruled that the the Court of Appeals here was in error in independently conditioning the grant of a patent on a requirement not embraced by the Statutes.

4. In making a ruling as to the necessity of an invention embraced by the applicant's disclosure, in the absence

5. *Ellis v. Shaw*, 295 Fed. 1006.

Prescott et al. v. Swain, 39 Fed. (2d) 241.

of any evidence supporting such ruling, and in the presence of positive unrefuted testimony, of one skilled in the art, showing that the subject-matter of the claims sought was inherent in the applicant's structure and that the applicant's device fully responded to all of the structural and functional requirements of such claims.

5. In not, pursuant to the previous mandate of this Court, in which the judgment below was reversed, granting the relief under Section 4915 R. S. prayed for by the plaintiffs.

6. In refusing to grant the plaintiffs a patent, with claims 46, 48 and 49, merely on the independent unsupported observations of the Court contrary to the unequivocal testimony, of one conceded to be skilled in the art, clearly establishing that the subject-matter of the claims sought found complete response both structurally and functionally in the applicant's disclosure.

Summary of Argument.

The argument is summarized in the foregoing petition and in the following arguments.

ARGUMENT.

Introductory Matter Leading Up to the Decision of the Court of Appeals.

Your Petitioners made due application for Letters Patent, including among other claims, Claims 46, 48 and 49,⁶ specifically here in issue.

These claims, which are concededly directed to patentable subject-matter by the Commissioner of Patents, were refused to the applicant on the sole ground that they were not supported by the disclosure in the Schultz application,⁷ as conceded by the Commissioner of Patents. Upon the refusal of these claims by the Patent Office, the applicant, pursuant to Section 4915 of the Revised Statutes,⁸ filed a timely bill in the District Court for the District of Columbia and a trial *de novo* was had in that Court.

Consistent with the accepted practice, the plaintiffs in this suit adduced testimony of a person skilled in the art to show that the invention of the three claims that had been refused, was inherent in the disclosure of the application. This practice was approved by the Court of Appeals for the District of Columbia in *re Manson*, 45 Appellate D.C. 563.⁹

6. Rec. pp. 113-114.

7. Rec. pp. 20-21.

8. 35 U. S. C. A. 63.

9. "If those skilled in the art making the article from the information furnished in the original application would naturally so construct it that it would have the capability here in question, this capability must be regarded as inherent in the applicant's disclosure and a necessary characteristic of his invention whether originally known to or appreciated by him or not."

Similar rulings were made by the same Court in the cases of:

Rogers et al. v. Aikman, 277 Fed. 617.

Ellis v. Shaw, 295 Fed. 1006.

Prescott et al. v. Swain et al., 22 Fed. (2d) 1004,

These decisions were in conformity with the promulgations of the Supreme Court in the case of *Eibel Process Company v. Minnesota & Ontario Paper Company*, 261 U.S. 45, decided by Mr. Chief Justice Taft, (Pages 65 and 66).¹⁰

The Court of Appeals recognized the correctness of this practice since that Court in its decision of December 17, 1945, in the present case¹¹ held that plaintiff was entitled to all the inherent subject matter of his application.¹²

There also does not appear to be any question but what the plaintiffs below did sustain their burden of proof in presenting testimony of a person conceded to be one skilled in the art which established that the feature of Claims 46, 48 and 49 in question was inherent in the applicants' dis-

10. "This patent and its specifications were manifested to readers who were skilled in the art of paper making and versed in the use of the Fourdrinier machine. The evidence discloses that one, so skilled, had no difficulty, when his attention was called to their importance, in fixing the place of the disturbance and ripples to be removed, or in determining what was the substantial pitch needed to equalize the speeds of the stock and wire at that place."

11. Rec. pp. 136-138.

12. "In our view of the case we are not required to rule specifically on the effect of the plaintiffs' alleged previous contradiction of the function which he now seeks to have made a part of his application. Nevertheless, it may be said that in view of the *Ellis* and *Prescott* cases, *supra*, it is doubtful if the plaintiff in such an action should be denied the inherent concomitants of his invention even in the presence of a description that is inconsistent with the fact of operation. This would seem to be particularly true, where, as here, the language used appears to be primarily directed toward describing a mechanical arrangement of parts rather than the functioning of the device."

closure and in the unquestioned models, plaintiffs' Exhibits 7, 11 and 13, corresponding to Figures 1, 4 and 5 of the application.¹³ In fact, the District Court below makes specific findings of fact to that effect, namely, findings of fact, numbers 4 and 10, previously alluded to in the foregoing petition.¹⁴

Claim 48 was treated below as being representative of the three claims in suit. The structure involved comprises a fuse having a movable tube disposed between spaced terminals and provided with means for locking the fuse to at least one of the terminals. The feature of the claimed structure, that is specifically in controversy, is defined, for example, in the last clause of Claim 48 as follows:

"* * * and means for moving the fuse tube longitudinally relative to said one of said fuse terminals to release said locking means."

This element in reality takes the form of a spring associated with the vertical fuse tube so as to exert force on the tube, when the tube is blown, to move it downwardly. The point specifically raised is whether that spring assists in the release of the latch. With reference to Figure 4 of the drawings of the application,¹⁵ which illustrates one form of the three species shown and which may be taken representative, reveals that the spring 66 surrounds the fuse tube 50 and coacts through the roller pin 60 with the latching arm 61.

The District Court, in its Findings of Fact, and more particularly findings 4 and 10¹⁶ found that this spring "presumably did expedite to some degree the consumma-

13. Rec. p. 98.

14. Rec. pp. 14 and 16.

15. Rec. p. 99.

16. Rec. p. 14 and 16.

tion of the unlatching process" and that "such operation might be held to be inherent in the fuse structure."

Similarly the Court of Appeals in its decision¹⁷ found that the plaintiffs had shown that the fuse tube in being thus biased downwardly contributed to the releasing action. This court erred, however, in ruling at the conclusion of its decision, that "the force of the fuse tube's downward thrust is not clearly and positively necessary to the release of the latch, that is, release may be consummated without the assistance of the pressure operative in the expulsion of the fuse tube."

Thus the question is now narrowed down to one of whether the Court of Appeals, in the light of its findings, was justified in **conditioning the grant of the patent on a showing that the use of the spring to move the tube and release the locking or latching means was necessary.**

Question or Point I.

Your Petitioners, after a careful study of the authorities, have not been able to find a single instance where it has been held that as a prerequisite to a patent it must be first shown that a feature or element of a structure claimed is necessary or indispensable. Notwithstanding the absence of legal precedent the Court of Appeals has ruled that the spring associated with the fuse tube of the plaintiff's fuse, was not shown to be necessary and hence the applicant was not entitled to the claims in suit. It is true that if the spring were omitted the fuse tube might drop by gravity, but obviously that would defeat the very purpose of the invention which, as set forth in the objectives of the application,¹⁸ is to provide one wherein a ruptured fuse link could be quickly withdrawn by the quick release

17. Rec. p. 138.

18. Rec. p. 98.

of the latch and so that any ensuing arc within the fuse tube would be quickly extinguished. If the spring associated with the tube was dispensed with then the only motivating power available for the tube would be gravity and we would not have a structure wherein the arc could be quickly extinguished.

According to the disclosure of the application, it is hence clear that the spring is functionally an important element of the fuse combination, and the applicant should not have been required to make any further showing as to the indispensability of this feature as a condition to getting a patent.

The Court of Appeals in analyzing the situation, as is clear from its decision, reasoned that this tube must be biased by the spring and since this is so it follows that the tube, which bears against the latching arm, exerts a force on the latching arm thus assisting in the release of the latching means. This is all that the claims in issue require and the disclosure of your petitioners' application does fully respond to that, both structurally and functionally.

There does not appear to be any need to cite many decisions in support of the present petition since this Court in the very recent case of *Special Equipment Co. v. Coe*, *supra*, specifically ruled on a parallel situation. The law of that case is clearly applicable to the present one, and the Court of Appeals was in error in not following the promulgations of this Court in that case.

In that case the Court of Appeals for the District of Columbia, in refusing a patent, conditioned the grant on a showing of intention to use the invention, and this Court in reversing the Lower Court held that the Statutes passed by Congress, including Sections 4915 R.S. 4886 and 4884 were controlling and that the Court of Appeals was not warranted in requiring conditions for a grant other than

those specified in the Statutes. In making this ruling this Court said "We have no occasion to consider here whether a better rule governing the grant of patents could be devised than that prescribed by Congress, as this Court has interpreted it."¹⁹

Since the statutes in question do not require, as a condition to the grant of a patent, a showing of intention to use an invention on which a patent is sought, this Court there, properly reversed the decision of the Court of Appeals.

So, too, here the pertinent sections of the Revised Statutes, make no requirement as to conditioning the grant of a patent on a showing of necessity for any feature of the invention. The Patent Office has itself conceded that the claims here in issue are patentable fuse combination claims, and neither the District Court nor the Court of Appeals has in any way indicated that such claims do not involve a patentable combination. To say that the applicant Schultz discloses an invention called for in the claims found to be patentable by the Patent Office and then to refuse him a patent because he has not made a showing of necessity for the invention is certainly inconsistent with the spirit and intent of the Revised Statutes, including Sections 4915 and 4886.

The Defendant, Commissioner of Patents, has at no time urged that the spring means cooperable with the fuse tube, as required by the claims, is not necessary. On the contrary, the defendant readily concedes that the combination involving this spring means is a patentable combination, thus admitting that the invention has utility. Also at no time in the trial was any question raised as to the lack of necessity for or utility of the invention.

It is submitted that since the spring does have utility,

19. P. 746.

which has not been questioned, it is, in reality, a necessary component of the invention and the Court of Appeals was wholly in error in its independent ruling.

Question or Point II.

It has long been established, as admitted by the Court of Appeals in its decision, that the test of whether an invention is inherent in a disclosure of an application, can be met by the testimony of one skilled in the art, showing that he did construct from the disclosure a device having the capability in question. Mr. McNulty produced three models²⁰ of the three forms of the invention, shown in Figures 1, 4 and 5 of the application, and testified that he constructed them from the disclosure. There is no question about this fact since the District Court made Findings of Fact²¹ to that effect and those findings have not been disturbed by the Court of Appeals. **The District Court went a step further and found that the models which were successfully operated in open court were unquestioned.**²²

It is submitted that anyone skilled in the art operating these unquestioned models will readily perceive that they satisfy in every respect the requirements of the claims sought by your petitioners.

The defendant in this cause introduced no testimony or evidence other than the Patent Office record itself, which was unsworn to, to refute the testimony of this witness who was skilled in the art. The District Court properly, therefore, ruled that they were unquestioned models.

It is, therefore, clear that the Courts below in reaching

20. Exhibits Nos. 7, 11 and 13.

21. Rec. pp. 13-16 inclusive.

22. Rec. p. 16.

their ultimate decisions did so on their own independent efforts and without any evidence to justify the assumption that the skilled witness, who testified, was in error. The Lower Courts, in the absence of any testimony at all, made rulings directly contrary to the sworn-to statements of one skilled in the art.

It would seem that if Section 4915 of the Revised Statutes is to have any force and effect, the defendant would have to refute evidence of this character if any showing is to be made out justifying a denial of the patent. Instead the defendant here relied solely upon the unsworn-to actions of the Patent Office Staff and made no effort to produce in Court as witnesses, the members of that Staff so that they would be available in Court for purposes of cross-examination. The District Court after trial, had before it on the one hand the sworn-to testimony of a person skilled in the art showing the claims in suit were supported by the application disclosure, and on the other hand, the unsworn-to statements of the Patent Office Staff to the contrary. In submitting this testimony, the plaintiffs met their burden of proof, approved by the practice in case of *Ellis v. Shaw, supra*, and it thereupon became incumbent upon the defendant to submit testimony refuting this position if the defendant was to maintain the position adopted by the Patent Office in refusing the claims.

If the practice were otherwise, the very purpose and intent of section 4915 of the Revised Statutes would be defeated and there would be no advantage to having a trial *de novo* if, after the plaintiff has made out a case, the defendant is held to prevail solely on the unsworn-to and uncorroborated statements of the Patent Office Staff. Yet that is what happened here since the defendant submitted no testimony whatsoever and the decisions of the Lower

Courts were, of necessity, therefore based solely upon the findings of the Patent Office.

While it might be argued that the members of the Patent Office Staff are technically skilled, that in itself does not mean that they are necessarily skilled in the art to which this invention relates, or more particularly in the practical aspects of the invention. A Patent Office Examiner is frequently an engineering college graduate, but usually he has had no practical experience in the field of his Examination. Thus for the most part, the Examiners' decisions are based on theory rather than on actual conditions of use and operation.

Moreover, the Patent Office practice does not provide for the submission of any testimony as to the actual use and operation of an invention, such as was adduced here. Apparently this is one of the very reasons for the existence of Section 4915 of the Revised Statutes since the statute does afford an applicant for patent, who has been refused claims, an opportunity to present testimony of one skilled in the art as to the actual practical aspects and operation of the invention.

If testimony of this character can be offset by the mere unsworn-to statements of the Patent Office Staff, then there is not much use in presenting such testimony and the practice which has been approved by the present Court of Appeals in *Ellis v. Shaw* and *Prescott et al. v. Swain*, *supra*, decisions, would be of no avail.

It is a cardinal rule in our system of jurisprudence that if statements of a party are to be relied upon as evidence in a trial, that party or person, if available, should be called as a witness so that the opposing party may have an opportunity to cross-examine as to such statements. There is no reason for departing from this firmly entrenched rule of evidence in a suit of this character, in-

asmuch as such a suit is not a bureau proceeding but is an equity suit, subject to trial in the same manner as any other suit in open court.

If the plaintiffs had adopted the alternative remedy, provided for by Section 4911 of the Revised Statutes, then, of course, the decision of the Court of Customs and Patent Appeals would have been merely on the record; but having proceeded by way of Section 4915 R.S., the plaintiffs were certainly entitled to a trial *de novo* and to have the evidence that they adduced given due and proper weight in accordance with the prevailing rules of evidence.

The Court of Appeals did not give this testimony the weight to which it was entitled, but instead rendered a decision, contrary to the weight of the evidence, affirming the Patent Office ruling. In fact, the Court of Appeals ventured an independent and unsupported reason for its decision, namely, that plaintiffs below had not shown a necessity for the invention. This clearly constitutes a complete disregard of the plaintiffs' constitutional and statutory rights with respect to the granting of patents, and unless the decision is reversed, irreparable damage will ensue not only throughout this land but all foreign countries accorded reciprocity privileges regarding patents here.

Conclusion.

In conclusion, it is submitted that the decision of the Court of Appeals contravenes the very spirit and intent of the Revised Statutes, as well as is directly contrary to the principles of law promulgated by this Court in the recently decided case of *Special Equipment Co. v. Coe, supra*. To allow the present decision to stand unmodified defeats the purpose which Congress intended, in enacting Section 4915-R.S., and would be tantamount to approving

the conditioning of the grant of a patent on requirements not embraced by Statutory law.

The judgment below should therefore be reversed.

Respectfully submitted,

CHARLES F. MERONI,
CARLTON HILL,
Counsel for Petitioners.

WILLIAM A. SMITH, JR.,
Of Counsel.

Dated: Chicago, Illinois,

March 26, 1946.



APPENDIX.

STATUTES:

Sec. 4884. R. S. (U.S.C., title 35, Sec. 40.) Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Sec. 4886 R. S. (U.S.C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (The period is two years instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, *infra*.)

Act of Aug. 5, 1939, 53 Stat. 1212:

Sec. 2. This Act (amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U.S.C., title 35, secs 31, 62, 69 and 73) by changing "two years" to one year) shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: Provided, however, That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

Sec. 4911 R. S. (U.S.C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes (U.S.C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the Board of Interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U.S.C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in Section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. (As to interferences declared prior to Oct. 5, 1939, see sec. 5 of Act of Aug. 5, printed after R. S. sec. 4904, *ante*.)

Sec. 4915 R. S. (U.S.C., title 35, Sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. (As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, printed after R. S. Sec. 4904, *ante*.)

Sec. 240 (a) of the Judicial Code (28 U.S.C. title 347). Certiorari to circuit courts of appeals and Court of Appeals of District of Columbia; appeal or writ of error to Supreme Court from circuit courts of appeals in certain cases; other reviews not allowed. (a) In any case, civil or criminal, in a circuit court of appeals, or in the Court of Appeals of the District of Columbia, it shall be competent for the Supreme Court of the United States, upon the petition of any party thereto, whether Government or other litigant, to require by certiorari, either before or after a judgment or decree by such lower court, that the cause be certified to the Supreme Court for determination by it with the same power and authority, and with like effect, as if the cause had been brought there by unrestricted writ of error or appeal.



INDEX

	Page
Opinions below.....	1
Jurisdiction.....	1
Questions presented.....	2
Statutes involved.....	2
Statement.....	2
Argument.....	6
Conclusion.....	12
Appendix.....	14

CITATIONS

Cases:

<i>Abbott v. Coe</i> , 109 F. 2d 449.....	7, 9
<i>Borden's Farm Products Co., Inc. v. Ten Eyck</i> , 297 U. S. 251.....	6
<i>Butterworth v. Hoe</i> , 112 U. S. 50.....	6
<i>Forward Process Co. v. Coe</i> , 116 F. 2d 946.....	7, 10
<i>General Talking Pictures Corp. v. Western Electric Co.</i> , 304 U. S. 175.....	12
<i>Great Atlantic and Pacific Tea Co. v. Grosjean</i> , 301 U. S. 412.....	6
<i>Hansgirk v. Kemmer</i> , 102 F. 2d 212.....	10
<i>Keller v. Adams-Campbell Co.</i> , 264 U. S. 314.....	12
<i>Layne & Bowler Corporation v. Western Well Works, Inc.</i> , 261 U. S. 387.....	12
<i>Morgan v. Daniels</i> , 153 U. S. 120.....	9
<i>Permutit Co. v. Graver Corp.</i> , 284 U. S. 53.....	10
<i>Railway Co. v. Sayles</i> , 97 U. S. 554.....	7
<i>Schriber Co. v. Cleveland Trust Co.</i> , 305 U. S. 47.....	7
<i>Special Equipment Company v. Coe</i> , 324 U. S. 370.....	11
<i>United States v. Commercial Credit Co., Inc.</i> , 286 U. S. 63.....	7

Statutes:

R. S. sec. 4888 (35 U. S. C. 33).....	7, 14
R. S. sec. 4915, as amended (35 U. S. C. 63).....	14

(1)



In the Supreme Court of the United States

OCTOBER TERM, 1945

No. 1042

LINE MATERIAL COMPANY AND WILLIAM O.
SCHULTZ, PETITIONERS

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court of the United States for the District of Columbia (R. 12-13) is not reported. The opinion of the United States Court of Appeals for the District of Columbia (R. 136-138) is reported at 152 F. (2d) 665.

JURISDICTION

The judgment of the District Court was entered on January 18, 1943 (R. 16-17). The judgment of the Court of Appeals (R. 139) was entered on December 17, 1945. A petition for rehearing was denied on January 7, 1946 (R. 140). The petition

for a writ of certiorari was filed on April 2, 1946. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the disclosure made in the Schultz patent application No. 727,250 is insufficient to support the claims here involved.

2. Whether the District Court and the Court of Appeals were bound, in the absence of testimony on behalf of the defendant, to accept the testimony and conclusions of a skilled witness produced by the plaintiff.

STATUTES INVOLVED

The statutes involved, R. S. § 4888 (35 U. S. C. 33) and R. S. § 4915 (35 U. S. C. 63), are set forth in the Appendix, *infra*.

STATEMENT

Petitioners, Schultz, the applicant for a patent, and Line Material Company, his assignee, brought suit in the District Court of the United States for the District of Columbia under R. S. § 4915 to obtain a judgment which would authorize the Commissioner of Patents to issue a patent containing certain claims of the Schultz application, No. 727,250 (R. 2-8).

The application was filed in the Patent Office on May 24, 1934. It relates to

* * * a novel form of fuse, such as the expulsion fuse type, in which the fuse tube operates first in the manner of an expulsion fuse, then moves downwardly and increases the gap in the circuit, and finally comes to rest projecting outwardly from the body portion so as to give a visual signal indicating that the fuse has blown. (R. 98.)

The primary examiner of the Patent Office allowed 49 claims of the application but refused to allow three other claims numbered 46, 48, and 49 (R. 113, 114) on the ground that they were not supported by the disclosure made in the application. This holding was affirmed by the Patent Office Board of Appeals (R. 122-124).

The District Court entered judgment dismissing the action (R. 16-17) on the ground that the Patent Office conclusions were not inconsistent with the evidence adduced before the court (R. 12). Petitioners appealed to the United States Court of Appeals for the District of Columbia, which affirmed on jurisdictional grounds (R. 128). This Court granted a writ of certiorari and reversed the judgment on the jurisdictional point, remanding the cause to the Court of Appeals for further proceedings. 325 U. S. 834. That Court (R. 136-139) thereupon affirmed the judgment of the District Court sustaining the action of the Patent Office.

The device disclosed in the Schultz application (R. 98-111) employs a fuse tube normally

held by a latch in an upper position. Within the tube is a fuse link which carries the current and which is adapted to break when an overload occurs. The fuse link is connected to the latch and holds it in latching position against the tension of a spring which is directly connected to the latch and tends to move it to released position. When the fuse link breaks, the latch is released by this spring. The fuse tube, being no longer supported by the latch, drops to a lower position. The downward movement of the fuse tube, after it is released by the latch, is expedited by a second spring, provided for this purpose.

As stated by petitioners (Pet. 17), the feature which is specifically in controversy and is variously stated in the three claims in issue (R. 113), is defined in claim 48 as follows:

* * * means for moving the fuse tube longitudinally relative to said one of said fuse terminals *to release said locking means.*
[Emphasis supplied.]

The claim was denied upon the ground that the second spring, which operates to expedite the downward movement of the fuse tube, is not the means for releasing the locking means (the latch), since the release of the latch is effected by the separate spring specifically provided on the latch for this purpose (R. 15).

At the trial in the District Court petitioners' expert witness produced and operated certain models based on the drawings of the Schultz

application (R. 32-80). The purpose of the demonstration was to show that when the locking means had been moved by its spring almost to its final released position, the second spring would have some effect in completing the release.

After this demonstration the District Court made the following finding of fact (R. 15) :

9. The degree to which the springs 15, 66, and 90 [the second spring described above, as variously numbered in drawings of variations of the device] may operate in the ultimate complete release of the latch is so slight as to be inconsequential and since the description of these springs and the operation thereof set forth in the specification of the Schultz application negatives the existence of any function thereof in effecting release of the latch, the application considered as a whole is not a disclosure of an apparatus in which the springs have this function.

The Court of Appeals in its decision stated (R. 138) :

An examination of the evidence offered at the trial seems to us to adequately support the result reached in the District Court. There is no question but that the spring actuating the latch arm must act first in effecting the release of the fuse tube. Otherwise the latch is useless in restraining the fuse tube from the circuit breaking position. This much being certain, the issue is narrowed to one of fact concerning the force, mode

of transmission, and time and direction of application exerted by the fuse tube [expedited by the second spring] to aid in opening the latch. We think the lower court justified in finding that the force flowing from the movement of the fuse tube was not necessary to the opening of the latch, that is to say, any force directed from the tube to the latch was gratuitous, not imperative to the unlatching.

ARGUMENT

The decisive question in this case is one of fact, namely, whether the disclosure made by petitioner was sufficient to support the claims here involved. The scope of appellate review in an action brought under the provisions of R. S. § 4915, insofar as it relates to a question of fact, is limited to the question of whether the finding that there was not sufficient disclosure is consistent with the evidence or is supported by the evidence. A proceeding under R. S. § 4915 is an equity action and follows the ordinary course of equity practice and procedure. *Butterworth v. Hoe*, 112 U. S. 50, 61. It is well established that the findings of fact of the trial court will not be disturbed unless clearly erroneous or without support in the evidence. *Borden's Farm Products Co., Inc. v. Ten Eyck*, 297 U. S. 251, 261; *Great Atlantic and Pacific Tea Co. v. Grosjean*, 301 U. S. 412, 420. The doctrine is applicable in principle to proceedings

under R. S. § 4915 and has been so applied by the court below in previous cases, e. g., *Abbott v. Coe*, 109 F. 2d 449, 451; *Forward Process Co. v. Coe*, 116 F. 2d 946, 947. It has peculiar force where, as here, the contested finding has been concurred in by both the Commissioner of Patents and the District Court. *Abbott v. Coe*, *supra* at p. 452; cf. *United States v. Commercial Credit Co., Inc.*, 286 U. S. 63, 67.

1. Throughout the petition the fact is emphasized that the claims at bar have been held patentable by respondent. This is true but immaterial to the question before the Court. That question is this: Does the Schultz application afford a basis for these claims? If not, then petitioners are not entitled to a patent based upon them regardless of whether the subject matter recited constitutes an invention. R. S. § 4888; *Railway Co. v. Sayles*, 97 U. S. 554, 563; *Schriber Co. v. Cleveland Trust Co.*, 305 U. S. 47, 57.

2. Also emphasized by petitioners is the fact that at the trial in the District Court respondent produced no witness to refute the testimony of petitioners' expert. Petitioners state (Pet. 22) that respondent "relied solely upon the unsworn-to actions of the Patent Office Staff * * *." This is not an accurate statement, for at the trial respondent relied on the sworn statements made by petitioner Schultz himself in his application

that his devices did not operate in the manner required by the claims at bar.¹

It is not accurate therefore to say that no evidence was offered to refute the testimony of peti-

¹ In the original specification (R. 101, 105) Schultz described his device and its operation as follows (*italics supplied*):

"The operation of the apparatus is as follows: When the fuse blows and the fuse link is ruptured, the lower pivoted contact member 29 is released and swings in a clockwise direction under the influence of the spring 33 [the first spring described in the statement, *supra*]. *This withdraws the hooklike arms 29 from the rollers 27 and thus releases the fuse tube 11.*

* * * *

"The operation of the apparatus is as follows: When the fuse blows, the member 71 rocks in the direction indicated by the arrow under the influence of the members 69. The cam-shaped portions 87 engage the upper faces of the arms 85 and rock the latches 84 out of engagement with the pins 83, thus releasing the fuse tube and allowing the fuse tube to be projected downwardly by means of the spring 90, and also assisted by the action of gravity.

"It is to be noted that the construction of the latching member is such *that the force of the spring urging the fuse tube downwardly is not transmitted to the fuse link and, consequently, does not strain the fuse link.* This may be true of all forms of the invention, as illustrated, but is particularly true and particularly desirable where a spring is employed to urge the fuse tube downwardly."

His original claim 13 (R. 110) contains the following:

"* * * a spring [the fuse tube spring], urging said fuse tube outwardly from said housing, latching means for normally restraining the outward motion of said fuse tube, a second spring urging said latching means toward releasing position, *the releasing motion of said latching means being independent of said first mentioned spring* [the fuse tube spring], and a fuse link electrically connecting said spaced contacts and restraining said latching means against releasing motion." [*Italics supplied.*]

tioners' expert. But even if there had been no evidence presented to refute the testimony and conclusions of the single expert witness produced by petitioners, the District Court was not bound to accept his testimony. A suit under R. S. § 4915 "is something in the nature of a suit to set aside a judgment, and as such is not to be sustained by a mere preponderance of evidence." It can be sustained only when the testimony "in character and amount carries thorough conviction." *Morgan v. Daniels*, 153 U. S. 120, 124, 125. "A mere preponderance of evidence' is not enough to justify reversing the Patent Office and deciding that an applicant is entitled to a patent." *Abbott v. Coe*, 109 F. 2d 449, 451.

It is clear from the findings and conclusions of the District Court that the expert's testimony was not persuasive that in petitioners' device the downward movement of the fuse tube, assisted by the spring which aids it, causes release of the latch. The demonstration models closely resembled the drawings of the Schultz application, but models made solely from drawings contain many characteristics beyond those found in the drawings, which may vitally affect the operation. In the present case, for example, the springs used in the models have certain strengths, the parts have certain weights, and there is a certain amount of friction between the moving parts. All of these characteristics may be varied by one

skilled in preparing models for demonstration purposes and cannot be gathered from drawings. Moreover drawings are of no avail to support a claim where there is an entire absence of description of the alleged invention or a failure to claim it. *Permutit Co. v. Graver Corp.*, 284 U. S. 53.

Here petitioners not only failed to provide a description of the operation required by the claims at bar, but their attempted description negatives such an operation. Hence the disclosure manifestly fails to meet the requirement of R. S. § 4888 that the application shall contain a full, clear, concise and exact description of the invention.

Petitioners urge (Pet. 8) that the court below found that the feature in question is inherent in the structure disclosed by Schultz. But the court below made no such finding. On the contrary, citing *Hansgirk v. Kemmer*, 102 F. 2d 212 (App. D. C.) and *Forward Process Co. v. Coe*, 116 F. 2d 946 (App. D. C.), it said (R. 137-138):

* * * If, as appellants have endeavored to prove, the unlatching could not in fact take place without the force exerted by the fuse tube, it seems clear that the function claimed is inherent in the device. * * *

* * * However, in our opinion, even giving the appellants the benefit of the construction most favorable to their position, they have failed to prove their case.

* * * * *

At best we believe no more was shown than that the fuse tube in biasing downward possibly contributes to the releasing action. This possibility is not sufficient to support the appellants' contention.

3. Petitioners seize upon the statement made in the decision of the lower court, that the District Court was right "in finding that the force flowing from the fuse tube was not necessary to the opening of the latch * * *" and argue that this statement contravenes the principles of law announced by this court in the case of *Special Equipment Company v. Coe*, 324 U. S. 370. But the cases are in no sense parallel. Here the question is quite different and is whether the Schultz application discloses what is called for in the claims at bar. In the *Special Equipment Company* case the question was, as stated in the decision, p. 371,

whether the Court of Appeals correctly rested its decision upon the ground that petitioner did not intend to make or use the invention and that the purpose of seeking the patent was to exploit and protect the combination invention embodied in the complete machine, of which the subcombination is a part.

The court below did not say that in the instant device the fuse tube spring is not necessary. That spring has its function, namely, to aid gravity in

forcing the fuse tube downward as Schultz stated in his specification (R. 103). To say, as the lower court did, that in the Schultz device the downward movement of the fuse tube was not necessary to the opening of the latch, was merely to say that opening of the latch is not done by movement of the fuse tube.

4. The ruling of the lower court obviously does not impair the patent system or raise a question of "tremendous public importance" (Pet. 9) in the light of understood procedures. The decision merely means that petitioners may only establish claims which are covered by the Schultz application.

As above noted, the issue is one of fact, namely, whether petitioners' disclosure supports the claims in question. That issue is similar to the issues of patentability, infringement, and scope of claim which ordinarily are not reviewed by this court. *Keller v. Adams-Campbell Co.*, 264 U. S. 314, 319; *Layne & Bowler Corporation v. Western Well Works, Inc.*, 261 U. S. 387; *General Talking Pictures Corp. v. Western Electric Co.*, 304 U. S. 175.

CONCLUSION

The decision of the court is correct, there is no conflict, and the petition does not raise a question calling for review for any other reason. We re-

spectfully submit therefore that the petition for a writ of certiorari should be denied.

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JOHN F. SONNETT,
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PAUL A. SWEENEY,
Attorney.

W. W. COCHRAN,
Solicitor of the Patent Office.

April, 1946.

APPENDIX

Revised Statutes, Sec. 4888, as amended (35 U. S. C. 33) provides as follows:

Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible.

Revised Statutes, Sec. 4915, as amended by the Act of March 2, 1927, c. 273, Sec. 11, 44 Stat. 1335, and Act of March 2, 1929, c. 488, Sec. 2 (b), 45 Stat. 1475 (35 U. S. C. 63), provides:

Whenever a patent on application is refused by the Commissioner of Patents, the

applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.